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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,945	07/11/2003	Heiner Glombik	02481.1832	2047
5487	7590	02/02/2005	EXAMINER	
ROSS J. OEHLER AVENTIS PHARMACEUTICALS INC. ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807			PESELEV, ELLI	
			ART UNIT	PAPER NUMBER
			1623	
			DATE MAILED: 02/02/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/616,945	GLOMBIK ET AL.	
	Examiner	Art Unit	
	Elli Peshev	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1-17 is/are rejected.

7) ☐ Claim(s) ____ is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: ____.

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds of Examples 5, 6, 7, 9, 11, 13, 34, 43, 44, 45, 47, 50, 54 and 56, and a method for lowering blood glucose with said compounds, does not reasonably provide enablement for compounds encompassed by the instant claims which are structurally significantly different from the compounds set forth in the above cited examples and a method of treating diabetes or lowering blood glucose with said compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification on page 38 presents data for 14 specific compounds. All but one of said compounds have structural formulas herein both R1 and R2 are hydrogen atoms and only one compound of example 54 has structural formula wherein R2 is F3. However, the instant claims encompass such structurally divergent compounds wherein, for example, R1 is CON[(C6)-alkyl]₂ and R2 is phenyl. Also, in the compounds tested the variable A represents C(O)CH₂CH₂, CH₂, CH₂CH₂ or CH=CH-CH₂, while the instant claims encompass such structurally unrelated compounds as, for example, wherein A represents -N((C1-C6)-alkylphenyl), NH, S or CHF. Further, in the compounds tested Cyc1 represents a thiophene group or a benzene ring. However, the instant claims encompass such structurally unrelated compounds as, for example, Cyc1 representing 3, 4 or 7 membered unsaturated or saturated ring, wherein 1 carbon atom is optionally replaced by O. Since even minor changes in chemical formulas can produce unpredictable changes in activity and since the treatment of diabetes is highly

unpredictable, there is a good reason to doubt that the compounds encompassed by the instant claims are effective for treating diabetes or lowering blood glucose levels.

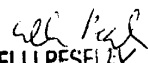
Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 11 are substantial duplicates. Note that claim 11 encompasses nothing more than compounds of claim 1 i.e. a pharmaceutically acceptable carrier has not been set forth.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peslev whose telephone number is (571) 272-0659. The examiner can normally be reached on 9.00-5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ELLI PESELEV
PRIMARY EXAMINER
GROUP 1200